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When Should Fashion Be Copyrightable?

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Abstract

This article examines when elements of fashion and clothing should be copyrightable. Copyright protection exists for original works of authorship fixed in any tangible medium. One of the categories of works of authorship that copyright protects includes pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. A useful article is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. While useful articles, taken as a whole, are not eligible for copyright protection, the individual design elements comprising these items may meet the Copyright Act's requirements if they are found to be conceptually separable.

This article will analyze the two tests for determining at which point fashion can be copyrightable. The first test is the aesthetic influence test adopted in *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Circ.2004). According to the aesthetic influence test if the elements of an article of clothing reflect the independent, artistic judgment of the designer, conceptual separability exists. When the design of a useful article is as much the result of utilitarian pressures as aesthetic choices, the useful and aesthetic elements are not conceptually separable. Conversely, the marketability test suggests that conceptual severability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be

marketable to some significant segment of the community simply because of its aesthetic qualities. This article argues that the marketability test is the preferable test for determining when an aspect of fashion is conceptually separable and can be copyrightable.

I. Introduction

The Copyright Office's view has long been that fashion design, particularly in the area of garment design, is uncopyrightable.[1] The main rationale for denying copyright to clothing and fashion is that "a garment is a 'useful article' whose aesthetic features are inseparable from its utilitarian function."[2] However, courts have begun addressing at what point certain elements of garment design contain artistic elements that are identified as separate, both physically and conceptually, from the utilitarian aspects of the clothing. [3] Courts have since been struggling to define conceptual separability in the realm of fashion design. *Masquerade Novelty, Inc. v. Unique Indus., Inc.,* specifically stated that courts have "twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function."[4]

There are a multitude of tests to determine when particular elements of fashion and clothing should be copyrightable, but this article will focus on two. The first test is the aesthetic influence test adopted in *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Circ.2004).

[1] Vermont, Samson, *The Dubious Legal Rationale for Denying Copyright to Fashion*, 21 TEX. INTELL. PROP. L.J. 89 (citing footnote 1).
[2] *Id*. at 90 (citing footnote 8).
[3] Perlmutter, Shira, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. Copyright Soc'y U.S.A. 339, 340
[4] *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir.1990).

According to the aesthetic influence test, conceptual separability exists when the artistic elements of an article can be conceptualized by existing independently of their utilitarian function. Conversely, when the design of a useful article is as much the result of utilitarian pressures as aesthetic choices, the useful and aesthetic elements are not conceptually separable. The second test is the marketability test, adopted in *Galiano v. Harrah's Operating Co*., Inc., 416 F.3d 411. (5th Circ. 2005). The marketability test suggests that conceptual severability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities. This article explores the rationales and application of both tests. This article argues that marketability is the preferable test for when an aspect of fashion can be copyrightable.

Part II examines the history of copyright law. Part III examines the goals and policies underlying copyright law. Part IV examines the Fifth Circuit's marketability test and its rationales and applications. Part V examines the Seventh Circuit's aesthetic influence test and its rationales and applications. Part VI argues that the Fifth Circuit's marketability test is the more preferable test because of the unique aspects of fashion design. Part VII argues that the aesthetic influence test does not further the goals of copyright law with respect to fashion design. Part VIII concludes. This article takes the position that the marketability test is best for determining the point in which an element of fashion can be conceptually separable from the fashion item itself because how fashion is marketed is part of the analysis as to how useful it can be.

II. The History of Copyright Law

Copyright protection exists for "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." [5] One category of a work of authorship that is entitled to copyright protection includes "pictorial, graphic, and sculptural works ("PGS" works). [6] In the context of fashion and garment design, PGS works are the aspects of garments that designers seek to have copyrighted. A PGS work is defined as:

> "[T]wo-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." [7]

Thus, "[i]f an item qualifies as a "useful article" under the Copyright Act, it is entitled to copyright protection only to the extent that its artwork or creative design is separable from the utilitarian aspects of the work." [8] "A 'useful article' is an article having an intrinsic utilitarian

[5] 17 U.S.C.A. § 102.
[6] *Id.*
[7] 17 U.S.C.A. § 101.
[8] *Galiano v. Harrah's Operating Co., Inc*., 416 F.3d 411, 414 (5th Cir.2005).

function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.'"[9] In terms of fashion and garment design, the "work of art" is normally incorporated into the garment itself and is considered an applied art.[10]

In *Mazer v. Stein*, 347 U.S. 201, the Supreme Court upheld the proper standard for determining when a work of applied art is entitled to copyright protection. In deciding whether statuettes of dancing figures on lamps were copyrightable, the court held that an ornamental design does not necessarily cease to be artistic when embodied in a useful article and may therefore be entitled to copyright protection. [11] While the *Mazer* decision exemplifies that copyright protection has been extended to cover articles having a utilitarian dimension, "Congress has explicitly refused copyright protection for works of applied art … which have aesthetic or artistic features that cannot be identified separately from the useful article."[12] Thus, in accordance with the Congress' and the *Mazer* court, courts generally require the physical or conceptual separability of a useful article, non-utilitarian aspects. [13]

Accordingly, the crucial issue in determining the copyrightability of fashion is determining whether or not the artistic or aesthetic aspects of the fashion garments are physically or conceptually separable from their utilitarian dimension.[14] More specifically, courts struggle

[9] 17 U.S.C.A. § 101.
[10] 37 C.F.R. § 202.8.
[11] *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F2d 411, 416 (2d Cir.1985)(citing *Mazer* at 214).
[12] *Id*. at 418 (citing H.R.Rep. No. 1476, supra, at 55).
[13] Thomas Byron, *As Long as There's Another Way: Pivot Point v. Charlene Products as an Accidental Template for Creativity-Driven Useful Articles Analysis*, 24 IDEA 147,148.
[14] *Galiano* 416 F.3d at 414.

with the point in which an applied art can be conceptually separable from a fashion garment. There are a multitude of tests for determining conceptual separability.

III. Goals of Copyright Law and Policies Underlying Copyright Law

In determining the appropriate test for conceptual separability in terms of fashion, it is pertinent to keep in mind the goals of copyright law. The preconditions and limits of copyright are predicated on important policy considerations mandated by the underlying utilitarian theory of American copyright jurisprudence.[15] The Constitution states that the purpose of copyright law is to "promote the Progress of Science and Useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their … Writings."[16] Moreover, according to the Supreme Court, creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and other arts.[17] Specifically, the Supreme Court in *Mazer* stated that, "the economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public efforts … the days devoted to such creativities deserve reward."[18] Congress' main intent was to provide authors with the incentive to create works.[19] This incentive to create was put in place in order to accomplish the overarching goal of providing public access to knowledge and expression and eventual public

[15] Byron, *supra* note 2, at 154.
[16] Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitably of Artistic Value Judgments*, 66 IND. L.J. 175, 178 (1990).
[17] Byron, *supra* note 2, at. at 154-55.
[18] *Mazer v. Stein*, 347 U.S. 201,219 (1954).
[19] Cohen, *supra* note 3 at 178.

access to the expression itself.[20] In *Dastar Corp. v. Twentieth Century Fox Film Corp*, the court, in analyzing copyright law, stated that, "the rights of a patentee or copyright holder are part of a 'carefully crafted bargain', under which, once the copyright monopoly has expired, the public may use the invention or work at will and without attribution."[21]

Copyright law mandates that the underlying basis of all creative expression, the idea, maintain in the public domain.[22] Thus, it follows, that in cases where the utility of the item is at issue, there must be a balance struck between allowing exclusive rights to what has been created and what copyright law should protect and what should not be protected by copyright law because it is in the domain of patent law, but does not meet the requirements of patentability. Patent protection is afforded to novel and useful designs[23], while copyright protection is afforded to "original works of authorship fixed in any tangible medium of expression, … from which they can be perceived, reproduced, or otherwise communicated, …".[24] In the realm of fashion design, copyright and patent laws intersect. Specifically, in terms of copyright law the idea is that of a dress or a pleated skirt, while the expression is the extra creative contribution by the designer. Additionally, in terms of patent law, in order to be afforded a patent that particular dress would need to be both useful and novel. It is pertinent to note that the idea remains in the public domain for the public to express in their unique ways.

[20] *See*, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (comparing the goals of Copyright law with the goals of Trademark law)
[21] *Id*. at 33-34.
[22] Jacob Bishop, *Stealing Beauty: Pivot Point International v. Charlene Products and the Unfought Battle Between the Merger Doctrine and Conceptual Separability*, 1005 WIS. L. REV. 1067, 1070.
[23] 35 U.S.C.A. § 101
[24] 17 U.S.C.A. § 102

This distinction between patent and copyright was first established in *Baker v, Selden*, where the court held that exclusive rights to the useful art described in a book might be available by patent, but the description itself was only protected by copyright, not patent.[25] The court analyzed whether a copyright in books detailing a bookkeeping system also protected the "exclusive right to the use of the system or method of book-keeping which the said books [were] intended to illustrate and explain."[26] The *Baker* court held that a work on the subject of book-keeping may be the subject of copyright, but there was a clear distinction between the book and art the book was intended to illustrate.[27] The court further stated that the novelty of the art illustrated had nothing to do with the validity of the copyright; rather awarding the author an exclusive property in the art described was a province of patent, not copyright.[28] Further, the court explicitly stated that, "by publishing the book, without getting a patent for the art, the latter is given to the public."[29] Thus, the court established the patents protect the methodologies while copyrights protect the expressions of the ideas that are reflected in the methodologies.

Moreover, intersection of the goals of patent and copyright law was specifically addressed in *Dastar Corp. v. Twentieth Century Fox Film Corp*.[30] The *Dastar* Court specifically stated that,

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[25] *Baker v. Selden*, 101 U.S. 99, 101 (1879).
[26] *Id.*
[27] *Id*. at 102.
[28] *Id.*
[29] *Id.* at 103.
[30] *See* generally, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (comparing the goals of Copyright law with the goals of Trademark law)

> "[T]he right to copy, and to copy without attribution, once a copyright has expired, like the 'right to make an article whose parent has expired – including the right to make it in precisely the shape it carried when patented --passes to the public.' 'In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.' The Lanham Act … does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity"

Thus, the *Dastar* established that once a copyrighted work or a patented invention passes into the public domain, any individual may do as they wish with that work or invention, without any attribution to the author. The court also established that the realm of copyright and patent law are distinct and certain aspects of the same article may be protected by patent law and others aspects by copyright law.

Thus, the designer's expression of the idea might not have anything to do with utility of the object, but the object may still remain useful even with the unique expression of the designer's idea. Furthermore, this expression of the idea might not be to the extent necessary to be considered conceptually separable and thus no copyright protection would be afforded. When determining whether artistic aspects of useful articles are conceptually separable from the utilitarian aspects of the articles, "jurisdiction over most useful articles has been allocated to the patent laws, which enforce a novelty standard that most useful articles cannot meet."[31] In the context of fashion design, the idea of a dress or pleated skirt while useful, would not be novel, so

[31] Kal Raustiala & Christoper Springman, *The Piracy Paradox: Innovation and Intellectual Property In Fashion Design*, 92 VA. L. REV. 1687, 1689 (2006).

no patent would be able to acquired for the garment designed. Thus, it becomes the case that aspects of fashion designs are not patentable because though useful, they are not novel and they are only copyrightable to the extent that the designs artistic aspects are conceptually separable from the utility of the garments themselves.

A main aspect of federal copyright law is that only expressions of ideas, not the ideas themselves, give rise to protected interests.[32] The idea/expression dichotomy has emerged as a doctrine of constitutional significance in assessing the degree of control of expression by copyright. [33] One of the main aspects of the idea/expression dichotomy is the appreciation that copyright law is limited in scope.[34] "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself."[35] This limitation on copyright protection is known as the merger doctrine, which states that "when there is only one way to express an idea, the expression of the idea 'merges' with the idea itself".[36] It further states that when the ideas and the expression contained in a work are inseparable, the entire work is unprotectable.[37] When an idea can be "divorced from and exist wholly outside the expression, the expression is deserving of copyright protection."[38] Thus, the expression of the idea of a dress would need extra creative contribution by the designer.

[32] *Id*. at 605.
[33] *Id*.
[34] *Id*. at 608.
[35] *Mazer*, 347 U.S. at 217.
[36] Bishop, *supra* note 4, at 1089.
[37] Dale P. Olson, *The Uneasy Legacy of Baker v. Selden,* 43 S.D. L. REV. 604, 609.
[38] Bishop, *supra* note 4, at 1089.

One of the first considerations in applying the idea/expression dichotomy is to determine whether the designer's idea and the expression are inseparable.[39] Thus, the threshold for copyrightability in the realm of separability has become something many courts struggle with. Accordingly, "the degree of copyright protection in a given work may shift from 'thick' protection, where protection may extend into the realm of abstractions, to 'thin' protection, where little . . . more than the specific expression is protected depending on the work."[40] Moreover, in the specific area of fashion, courts have been struggling with how to define conceptual separability, how to accommodate the potential conflict with patent law, and whether to award fashion designs with thick or thin copyright protection. The courts have applied various tests as to how to determine conceptual separability and each test awards a different degree of copyright protect to the article of fashion in question. The test that awards a thinner protection is the marketability test and the test awarding a thicker protection is the aesthetic influence test.

IV. The Marketability Test

The marketability test was first formally adopted in *Galiano v. Harrah's Operating Co., Inc.*. In *Galiano*, a clothing designer sued a casino operator for infringement of copyrights in uniform and costume designs.[41] The designer of a uniform for employees of Harrah's employees entered into a manufacturing agreement with one of Harrah's suppliers to produce the uniforms.[42] The designer received copyright protection for a collection of sketches for Harrah's

[39] *Id.*
[40] Byron, *supra* note 2, at 159.
[41] *Galiano* 416 F.3d at 412.
[42] *Id* at 413.

uniforms classifying the sketches as "Artwork for Wearing Apparel". [43] After the agreement between the designer and Harrah's ended, Harrah's continued to use the designer's uniforms and the designer sued for copyright infringement for continuing to use her uniform designs after the agreement had ended.[44] The issue before the court was whether or not the uniforms were original and thus sufficiently copyrightable.[45]

In *Galiano*, the court applied a two-part test for determining whether the designer could copyright the uniform designs. First, the court had to determine whether the uniforms were useful articles and then the courts had to determine whether the design incorporated PGS features that could be identified separately from, and could exist independently of the utilitarian aspects of the article.[46] The court found that uniforms were in fact useful and thus the pertinent issue before the court was determining whether or not the uniform designs were conceptually separable from the utilitarian aspects of the uniform.[47]

In determining how to address the conceptual separability issue, the court analyzed Professor Melville B. Nimmer's test.[48] The conceptual separability test presented Professor Nimmer stated that, "conceptual separability exists where there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."[49] Professor Nimmer also discussed the

[43] *Id.*
[44] *Id* at 414.
[45] *Id.*
[46] *Id.* at 416.
[47] *Id.*
[48] *Id.*
[49] *Id.* (citing NIMMER ON COPYRIGHT § 2.08[B][3], at 2-101)

scope of copyright protection in design works and found that fabric designs may include patterns or artistic features imported onto a fabric or appear repeatedly throughout the dress fabric and because one can generally separate the artistic elements of this design from the utility of the wearable garment, fabric designs are generally entitled to copyright protection.[50] However, dress designs that were generally set for the shape and style of the garment were typically not entitled to copyright protection because the artistic elements usually cannot be separated from the utilitarian aspect of the garment.[51] Ultimately, the *Galiano* court applied the Nimmer's test because it was a determinate rule and the court adopted the likelihood-of-marketability standard specifically in the context of garment design.[52]

Thereafter, In *Varsity Brands, Inc. v. Star Atheltica, LLC,* the court examined whether or not the colors-and-designs component of a cheerleading uniform could be conceptually separable from the utilitarian object itself.[53] Star Athletica was a designer of various sports apparel and Varsity sports designed apparel and accessories specifically for use in cheerleading.[54] Varsity copyrighted various designs of cheerleading uniforms, which it claims Star Athletica reproduced in its catalog.[55] Varsity subsequently sued Star Atheltica for copyright infringement.[56] In deciding whether or not a copyright was infringed, the court once again was confronted with a conceptual separability issue. The court in *Varsity Brands* examined the various conceptual separability tests that could be applied. Ultimately, the court in *Varsity Brands* adopted the fifth

[50] *Id*.
[51] *Id*.
[52] *Id.*
[53] *Varsity Brands, Inc. v. Star Atheltica, LLC*, 2014 WL 819422 (W.D.Tenn.)
[54] *Id*. at 2228.
[55] *Id*. at 2231-36.
[56] *Id*.

circuit's marketability test and found that it was unlikely that the uniform designs would be marketable outside of their utilitarian function as cheerleading uniforms.[57]

Prior to formally adopting the marketability test, other courts had applied the test based on Nimmer's analysis, without identifying it as the marketability test. For example, in *Kieselstein-Cord v. Accessories by Pearl, Inc.,* the court applied the conceptual separability test for belt buckles.[58] In *Kieselstein-Cord,* the designer created a series of belt buckles that he stated were inspired by a book.[59] The court stated that they saw in the designer's belt buckles conceptually separable sculptural elements because the buckles' wearers had used them as ornamentations for parts of the body other than the waste.[60] Thus, this exemplified the fact that the ornamental aspect of the belt buckles was conceptually separable from their subsidiary utilitarian function.[61] The court in *Kieselstein-Cord* explicitly stated that its conclusion was not a variance from the "expressed congressional intent to distinguish copyrightable applied art and uncopyrightable industrial design."[62] Since the belt buckles were applied art and were considered jewelry, the buckles used as a jewelry form were subject to copyright protection.[63] Thus, while the marketability test was not specifically identified, the marketability test was still applied because the court found that consumers were purchasing the belt buckles not to use as belt buckles, but also to use as jewelry because they appreciated the applied art in the belt buckle to that extent. The buckle proved to be marketable not because people needed a belt buckle, but because they liked the design.

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[57] *Id*. at 8.
[58] *Kieselstein-Cord v. Accessories by Pearl, Inc.,* 632 F.2d 989 (2d Cir.1980)
[59] *Id*. at 990
[60] *Id*. at 993
[61] *Id*.
[62] *Id*.
[63] *Id*.

Additionally, in *Poe v. Missing Persons*, the court had to address whether a utilitarian article of clothing, in this case a swimsuit, was a work of art.[64] The designer described his swimsuit as standing itself as a piece of "conceptual art".[65] He described it as such because a musician wore the swimsuit only once, when she was photographed for her album cover.[66] Thus, it was the artist's contention that the swimsuit was used solely as a piece of visual art.[67] The lower court, in granting summary judgment, cited to *Nimmer on Copyright* and held that the swimsuit in question was not copyrightable because "the functional aspects of the swimsuit [were] not independent of the alleged sculptural/artistic aspects of the suit." [68] On appeal, the court held that summary judgment should not have been granted because there was a genuine issue of material fact as to whether the swimsuit's sculptural features could be identified separately and that one of the district court's considerations should be whether the admissibility of evidence of the swimsuit's marketability as a work of art, again referencing *Nimmer on Copyright*.[69] Once more, though the marketability test was not specifically identified, the marketability test was still a major consideration by the lower court and the higher court in assessing whether the swimsuit was marketable because it was designed as a work of art to be used for an album cover and not for its functional purpose as a swimsuit.

[64] *Poe v. Missing Persons*, 745 F.2D. 1238 (9th Cir.1984)
[65] *Id*. at 1240
[66] *Id*. at 1241.
[67] *Id*. at 1242.
[68] *Id*. at 1241.
[69] *Id*. at 1243.

Ultimately, courts that have applied the marketability test have relied on the Nimmer analysis as to when fashion designs deserve protection.[70] They have sought to find specific instances that exemplified that individuals had recognized the artistic aspect of on an article of fashion to the extent they were no longer purchasing it for its utilitarian purchase. Thus, proof of the article of fashion having its design marketable to some significant segment of the community simply because of its aesthetic qualities is essentially the essence of the marketability test.[71]

V. The Aesthetic Influence Test

The aesthetic influence test was first officially adopted in *Pivot Point Intern., Inc. v. Charlene Products Inc.*.[72] In *Pivot Point*, the court held that a face of a mannequin that portrayed the 'hungry look' of a high fashion runway model met the requirements for conceptual separability and was subject to copyright protection.[73] In reaching its conclusion, after the court found that the mannequin was considered a useful article, the court then had to determine whether the mannequin's 'hungry look' was conceptually separable from its utilitarian aspect.[74] The *Pivot Point* court struggled with the correct test to apply for determining conceptual separability.[75]

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[70] Byron, *supra* note 2,179 (stating that the Nimmer test "predicates a useful article's copyrightability on the opinion of a collective of consumers … a useful article passes muster 'where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities'")
[71] *Id.*
[72] *Pivot Point Intern., Inc. v. Charlene Products Inc.*, 372 F.3d 913 (7th Circ.2004).
[73] *Id.*
[74] *Id.* at 920.
[75] *Id.* at 923.

Ultimately, the court adopted its own test for conceptual separability that stated that conceptual separability exists when "the artistic aspects of the article can be conceptualized as existing independently of their utilitarian function."[76] The court went on to state that this independence would be informed by,

> "[W]hether the design elements can be identified as reflecting the designer's artistic judgment exercised indecently of functional influences. If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is 'as much the result of the utilitarian pressures as aesthetic choices,' the useful and aesthetic elements are not conceptually separable."[77]

Applying this test, the *Pivot Point* court determined that conceptual separability existed because the "hungry look" expression of the mannequin was the product of the designer's artistic judgment.[78] The court stated that the artist carefully thought about the dimensions of every aspect of the face and the "hungry look" was "purely the product of an artistic effort."[79] Thus, copyright protection was granted to the "hungry look" of the mannequin.[80]

The *Pivot Point* "aesthetic influence" test was again applied in the Fourth Circuit in *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, in a case involving decorative

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[76] *Id*. at 931 (citing *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d. 411, 418)
[77] *Id.* (citing *Brandir Intern., Inc. v. Casvade Pacific Lumber Co.*, 832 F.2d 1142, 1145)
[78] *Id.*
[79] *Id*. at 932.
[80] *Id*. at 932.

carvings on furniture.[81] The court held that the decorative elements of the designer's furniture designs could receive copyright protection because the furniture compilations were "superfluous nonfunctional adornments for which the shape of the furniture (which is not copyrightable) serves as the vehicle … the designs are whole unnecessary to the furniture's utilitarian function."[82] The court recognized that while the furniture designer was influenced by function when designing the decorative elements, it was still apparent that the designer's artistic judgment was sufficiently independent because his objective in making the decorative elements was not to improve the function, but to "give the pieces a pretty face."[83]

Seemingly, courts that have applied the *Pivot Point* aesthetic influence test focus primarily on the designer's artistic judgment (though at most times this may be hard to discern). Courts look to the intent of the designer and set out to determine whether the specific object is made with intent to be "seen and admired". [84] Thus, reiterating that conceptual separability will be found to exist when the artistic aspects of an article can be conceptualized as existing independently of their utilitarian function.[85] While courts have found that perhaps the functionality of a utilitarian may be a consideration when making the design, it cannot be the as much of a consideration as the actual design itself.[86]

VI. The Marketability Test is the More Preferable Test for Copyrighting Elements of Fashion

[81] *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 424 (4th Cir.2010).
[82] *Varsity Brands,* 2014 WL 819422 (citing *Universal Furniture Int'l* at 434).
[83] *Id.*
[84] *Id.* at 4.
[85] *Pivot Point*, 372 F.3d at 931.
[86] *Universal Furniture*, 618 F.3d at 434.

In terms of copyrighting fashion, the standards courts have used as to when a copyright should be granted tend be quite high, as is exemplified from the decisions of the cases discussed above. Thus, the level of copyright protection awarded to fashion is seemingly very thin. Specifically, in *Galiano,* the court adopted a demanding test in which a copyright would only be granted for an article of fashion if the article's artistic qualities were so paramount that the design would be marketable as an artistic work independent of its utilitarian use.[87] The marketability test establishes the thin level of protection that is necessary in fashion industry.

Kal Raustiala, Christopher Sprigman in their article, *The Piracy Paradox: Innovation and Intellectual Property In Fashion Design,* argued that copying in the fashion industry is almost a necessary predicate to the apparel industry's "swift cycle" of innovation.[88] The authors stated that in most instances the designs on articles of fashion, such as a beaded applique, are not conceptually separable from the garments themselves because the designs are usually a part of the garment themselves (i.e. beading on the sleeve of a shirt).[89] Thus, in most instances the designs on garments do not qualify as being conceptually separable and the designs do not receive copyright protection. However, the authors argued that the lack of copyright protection in the fashion industry has given designers incentive to continue to innovate at a quicker pace and may actually promote fashion industry overall.[90]

[87] Vermont Samson, *The Dubious Legal Rationale for Denying Copyright to Fashion*, 21 TEX. INTELL. PROP. L.J. 89 (2013)
[88] Raustiala & Springman , *supra* note 5, at 1691.
[89] *Id*. at 1700.
[90] *Id*. at 1775-76.

The fashion industry thrives on innovation and new designs every season. "The fashion industry profits by repeatedly originating creative content … [and] design copying is ubiquitous. Nonetheless, the industry develops a tremendous variety of clothing and accessory designs at a rapid pace. The standard theory of IP rights predicts that extensive copying will destroy the incentive for new innovation. Yet, fashion firms continue to innovate at a rapid clip, precisely the opposite behavior of that predicted by the standard theory."[91] It has been argued that piracy accelerates fashion trends and 'thereby fuels status-seeking arms races among consumers that continually spur demand for new designs – the 'piracy paradox'."[92] Thus, the idea of the piracy paradox is that the right to piracy, particularly in the area of fashion design, helps the fashion industry.[93]

Ultimately, the fashion industry has been able to operate with a thin level of copyright protection and innovation has not been deterred. While it is likely that, generally, garments and other elements of fashion design do not have artistic elements that are conceptually separable from their utilitarian aspects, it is pertinent to recognize that there are in fact instances in which they are conceptually separable and those instances deserve adequate protection under the copyright law. Taking the concept of the "piracy paradox" together with the acknowledgement that there are times in which artistic elements of fashion may be conceptually separable from the utilitarian aspect of clothing design, means that a stringent and demanding test should be adopted for conceptual seperability with respect to fashion design. A stringent and demanding test

[91] *Id.* at1689.
[92] Samson, *supra* note 7, at 99.
[93] *Id.*

would further the goals of copyright law while encouraging designers to keep innovating new designs for the changing fashion seasons.

Accordingly, a thin layer of copyright protection is necessary for fashion design. The policies underlying copyright law include encouraging people to create, while also not restricting the availability of the creations to the public. In order to continue to promote the fashion industry and incentive the designers to make unique designs, *Galiano's* marketability test is the more appropriate test for conceptual separability as it applies to fashion design. The marketability test only defines design elements as being conceptually separable when it can be considered art that is independent of the utilitarian aspect of the fashion garment.[94] Thus, the test provides adequate protection to the designer if the design element is marketable as an artistic work independently, but not too much protection so as to limit other designers from creating.

VII. The Aesthetic Influence Test Does not Further the Goals of Copyright Law with Respect to Fashion Design

The *Pivot Point* aesthetic influence test finds conceptual separability when the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences. [95] As stated above, the overarching goal of Copyright is providing public access to knowledge and expression and eventual public access to the expression itself.[96] More narrowly the goal of Copyright law is to encourage and incentive individuals to create

[94] *Galiano* 416 F.3d at 419.
[95] *Pivot Point*, 372 F.3d at 931.
[96] *See* generally, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (comparing the goals of Copyright law with the goals of Trademark law)

works and provide them with a reward and protection for this individual effort.[97] The aesthetic influence test seems to accomplish the goals of copyright law be rewarding a designer for the expression of his independent artistic judgment.[98] However, this test focuses heavily on creativity and consequently results in a very permissive standard.[99] "Protecting works inasmuch as they satisfy creativity would … introduce protection to works based on the aesthetic satisfaction that may accompany creativity."[100] In the realm of fashion design the threshold for copyright protection is too low because and in reality, the aesthetic influence test may affect influences other than the artist's own independent judgment. Moreover, the House Report, in attempting to "limit the practical breadth of conceptual separability," explicitly stated that, " although the shape of an industrial product may be aesthetically satisfying … the Committee's intention is not to offer it copyright protection under the bill."[101] Thus, the aesthetic influence seems to run contrary to the Committee's intent by rewarding artistic judgment that may be aesthetically satisfying, without more.

Additionally, it is worth noting that in *Pivot Point*, copyright protection was afforded to the "hungry look" of a mannequin, which was not necessarily based on the artist's independent idea of what is beautiful, rather on a prevailing idea of beauty established in that era.[102] Jacob Bishop, author of the note, *Stealing Beauty: Pivot Point International v. Charlene Products and the Unfought Battle Between the Merger Doctrine and Conceptual Separability*, argues that while the aesthetic influence test adopted in *Pivot Point* may seem to protect artistic designs on

[97] *Mazer*, 347 U.S. at at 219.
[98] *Pivot Point*, 372 F.3d at 931.
[99] Byron, *supra* note 2, at 187.
[100] *Id*. at 191.
[101] *Id*. (quoting H.R. REP. NO. 94-1476, at 55 (1976))
[102] Bishop, *supra* note 4, at 1071-72.

the surface, it simultaneously "stif[les] other legitimate designs."[103] The note ultimately concludes that the aesthetic influence tests fails to reconcile the merger doctrine with conceptual separability to the detriment of future artists or fashion designers.[104]

Jacob Bishop argued that in adopting the aesthetic influence test adopted in *Pivot Point* is flawed because it seems to grant copyright protection to the idea itself, rather than to the expression of the idea.[105] An idea must be divorced from and exist wholly outside the expression, and only the expression is deserving of copyright protection.[106] The *Pivot Point* court in adopting the aesthetic influence test afforded copyright protection to an artistic aspect of a utilitarian article that should not have been afforded copyright protection due to the merger doctrine.[107] Accordingly, the aesthetic influence test puts directly in conflict the doctrine of conceptual separability and the merger doctrine.[108]

Furthermore, it is pertinent to note that the standard for conceptual separability expressed through the aesthetic influence test is a much more permissive standard than the marketability test.[109] As Judge Kanne stated in his dissent,

> "All functional items have aesthetic qualities. If copyright provided protection for functional items simply because of their aesthetic qualities, Congress's policy …

[103] *Id*. at 1072.
[104] *Id*.
[105] *Id*. at 1089.
[106] *Id*. at 1090.
[107] *Id*. at 1098.
[108] *Id*. at 1100.
[109] Byron, *supra* note 2, at 187.

would be undermined."[110]

Judge Kanne further stated that *Pivot Point* holding was contrary to the two part test derived from the Copyright statute, which was concerned with protecting only non-utilitarian features of the useful article.[111] In *Pivot Point*, where the hungry look of the mannequin was given copyright protection, the mannequin would not be considered useful without that hungry look and the functionality would be greatly diminished or eliminated.[112] Moreover, Judge Kanne argues that the "process-oriented" approach focused on by the majority is even more flawed, because Pivot Point intended for the mannequin to serve a functional purpose in its process.[113] Accordingly, it is apparent that the *Pivot Point* test goes against the goals of copyright law and too easily affords copyright protection. This is particularly harmful in the area of fashion design because it would hinder innovation of fashion designs.

VIII. Conclusion

The underlying goals of copyright have fundamentally been to encourage the expression of ideas with the ultimate goal of providing the maximum public good.[114] Hence, an appropriate test for conceptual separability would work to advance those goals. Additionally, in the case of

[110] *Pivot Point*, 372 F.3d at 932.
[111] *Id*. at 933-34. The two-part test is whether the useful article incorporates sculptural features that can be identified separately from the utilitarian aspects of the article and whether these features are capable of existing independently from their utilitarian aspects.
[112] *Id* at 934.
[113] *Id*.
[114] Byron, *supra* note 2, at 195.

fashion design, an important consideration is how quickly fashion seasons change and how incentivized designers already are as a result of the changing seasons to continue creating. Thus, a test awarding thin copyright protection in the fashion industry would both advance copyright goals and designers would remain encouraged to create. *Galiano's* marketability test ensures that art that can exist independently and not only on a useful article as it relates to fashion design will still be protected, but does not award much more protection than that. With such a demanding test, fashion designers will have to keep creating and keeping up with trends in order to make sure that the fashion industry continues to thrive. Additionally, the test is able to take into consideration both the merger doctrine and the doctrine of conceptually separability without having the two doctrines conflict with one another. As such, the application of *Galiano's* marketability test to measure at which point an element of fashion design is conceptually separable from the utilitarian aspect of a useful article, and thus copyrightable, is most appropriate in the fashion industry.